

**AMENDMENT UNDER 37 C.F.R. 1.116**

**EXPEDITED PROCEDURE**

**EXAMINING GROUP 3628**

**PATENT**

**Serial No. 09/650,733**

**Attorney Docket No. 1011-002**

**REMARKS**

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claim 112 has been amended to make explicit that which was implicit in the claim as originally filed, thereby not changing the scope of the claim. Claims 1-139 are now pending in this application. Claims 1, 112-114, and 136-139 are the independent claims.

**The Obviousness Rejection**

Claims 1-139 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Atkins (U.S. Patent No. 5,644,727) in view of Jones (U.S. Patent No. 6,021,397). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” See MPEP § 2143.

To the extent that official notice is taken to support the rejection, Applicants respectfully traverse and request citation and provision of a reference that supports the rejection. See MPEP

2144.03. For example, Applicant traverses as legally insufficient the continued assertion of “common sense” as a motivation or suggestion to combine Atkins with Jones, and Applicant respectfully requests a specific citation and provision of a reference that provides the alleged motivation or suggestion to combine. As another example, Applicant traverses as legally insufficient the assertion that “the practice of outsourcing per se is old and well known”, and Applicant respectfully requests a specific citation and provision of a reference that evidences the assertion.

No Examiner interview has yet been held with respect to the present application. To the extent that any rejection relies upon alleged statements by the Applicant at an interview involving the present application or a different patent application (as implied in the first full paragraph on page 5 of the Office Action), Applicant respectfully requests contemporaneous documentation of the specific statements upon which the rejection relies.

As defined at line 12 on page 10 of the application, an **“agent”** is a **“financial risk manager”**. Applicant apologizes for the error in citing this page number in the previous Reply. Nevertheless, this explicit definition of an **“agent”** has always been apparent in the application.

Claims 1, 112-114, and 136-139 recite **“a plurality of institutional or corporate clients”**. Claims 1, 112-114, and 137-139 recite **“receiving financial information at a computer of the agent”**. Claims 1, 112, and 113 recite **“demonstrating that more than one activity of the agent is transparent to the client”**. Claim 138 recites **“demonstrating to the client the potential transparency of activities of the agent”**. Claims 114, 136, and 137 recite **“enabling the agent to determine an action based on an analysis of risk management information created from the**

financial information.” Claim 139 recites “enabling the client to **monitor through a network** activities of the **agent**”.

As continues to be recognized in the Office Action, “Atkins does **not** explicitly teach an agent... or transparency....” Jones does not cure this deficiency.

As recognized by the Office Action at the bottom of page 4, the combination of Atkins and Jones do not establish a prima facie case of obviousness.

Filed herewith is a 37 CFR § 1.132 Declaration of Dr. William W. Sihler, a professor of Business Administration and Finance at University of Virginia, and one skilled in the art of financial management and financial services.

The Declaration of Dr. Sihler is timely submitted for one or more of at least the following:

1. the Office Action’s new assertion that the “amendments made (technology and intended use) do not alter the basic words of the claims originally examined...”, thereby implying that all of the limitations of the claims were not properly examined;
2. the Office Action’s new assertion that “[t]hese activities, steps, methods, and means are not novel...”, thereby implying that in addition to the obviousness rejection, the Office Action is asserting a new, and unsupported, novelty rejection as well;
3. the Office Action’s issuance of the new ground of rejection that “the words ‘institutional or corporate’ are merely an intended use”;
4. the Office Action’s refusal to properly recognize the added claim limitation “institutional or corporate”,

5. the Office Action's continued refusal to properly recognize the explicit definition of "agent";
6. the Office Action's new assertion that "this invention is essentially the outsourcing of many, if not all, common and well known financial functions of one company to an agent at another company", without the specific citation and provision of a reference that evidences the assertion;
7. the Office Action's new assertion that "[t]here is no difference in the functions performed or how they are performed", without the specific citation and provision of a reference that evidences the assertion; and
8. the Office Action's new assertion that "the practice of outsourcing per se is old and well known", without the specific citation and provision of a reference that evidences the assertion.

Applicant respectfully traverses each of the above-listed actions or assertions manifested in the Office Action.

Paragraphs 10-14 of Dr. Sihler's Declaration establish that one skilled in the art would not find that Atkins teaches or suggests an "agent" as that term is defined in Application Serial No. 09/650,733.

Paragraph 15 of Dr. Sihler's Declaration establishes that one skilled in the art would not find that Jones teaches or suggests an "agent" as that term is explicitly defined in Application Serial No. 09/650,733.

Paragraphs 16-18 of Dr. Sihler's Declaration establish that one skilled in the art would not view the recitation of an "institutional or corporate client" as merely an intended use, but instead

**AMENDMENT UNDER 37 C.F.R. 1.116**

**EXPEDITED PROCEDURE**

**EXAMINING GROUP 3628**

**PATENT**

**Serial No. 09/650,733**

**Attorney Docket No. 1011-002**

would view those words as required limitations of each of claims 1-139 and defining the type of “client” cited in those claims.

Paragraphs 19-22 of Dr. Sihler’s Declaration establish that one skilled in the art would not find that Atkins teaches an “institutional or corporate client”.

Paragraphs 23-25 of Dr. Sihler’s Declaration establish that one skilled in the art would not find that Jones teaches an “institutional or corporate client”.

Paragraphs 26-27 of Dr. Sihler’s Declaration establish that one skilled in the art would not find that Atkins teaches or suggests “receiving financial information at the agent” or “receiving financial information at a computer of the agent”,

Paragraph 28 of Dr. Sihler’s Declaration establishes that one skilled in the art would not find that Jones teaches or suggests “receiving financial information at the agent” or “receiving financial information at a computer of the agent”,

Paragraphs 29-31 of Dr. Sihler’s Declaration establish that one skilled in the art would not find that Atkins teaches or suggests “demonstrating to the client the potential transparency of activities of the agent....”, “transparency of activities of the agent”, or “transparency” as those terms are used in Application Serial No. 09/650,733.

Paragraphs 32-35 of Dr. Sihler’s Declaration establish that one skilled in the art would not find that Jones teaches or suggests “demonstrating to the client the potential transparency of activities of the agent....”, “transparency of activities of the agent”, or “transparency” as those terms are used in Application Serial No. 09/650,733.

**AMENDMENT UNDER 37 C.F.R. 1.116**

**EXPEDITED PROCEDURE**

**EXAMINING GROUP 3628**

**PATENT**

**Serial No. 09/650,733**

**Attorney Docket No. 1011-002**

Paragraphs 36-38 of Dr. Sihler's Declaration establish that one skilled in the art would not find that Atkins teaches or suggests "enabling the agent to determine an action based on an analysis of risk management information created from the financial information".

Paragraph 39 of Dr. Sihler's Declaration establishes that one skilled in the art would not find that Jones teaches or suggests "enabling the agent to determine an action based on an analysis of risk management information created from the financial information".

Paragraphs 40-42 of Dr. Sihler's Declaration establish that one skilled in the art would not find that Atkins teaches or suggests "enabling the client to monitor through a network activities of the agent...."

Paragraph 43 of Dr. Sihler's Declaration establishes that one skilled in the art would not find that Jones teaches or suggests "enabling the client to monitor through a network activities of the agent...."

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption for which no proper evidence has been presented and with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption for which no proper evidence has been presented and with which the applicant disagrees), the cited references still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly

**AMENDMENT UNDER 37 C.F.R. 1.116**

**EXPEDITED PROCEDURE**

**EXAMINING GROUP 3628**

**PATENT**

**Serial No. 09/650,733**

**Attorney Docket No. 1011-002**

asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

As requested in the previous Reply, and as mandated by MPEP 706.02(j), to the extent that any rejection is maintained or any new reference-based rejection is advanced, Applicant respectfully requests recitation of **specific** passages in each reference by column and line number, as opposed to citing to the entire textual portion of each reference.

**AMENDMENT UNDER 37 C.F.R. 1.116**

**EXPEDITED PROCEDURE**

**EXAMINING GROUP 3628**

**PATENT**

**Serial No. 09/650,733**

**Attorney Docket No. 1011-002**

**CONCLUSION**

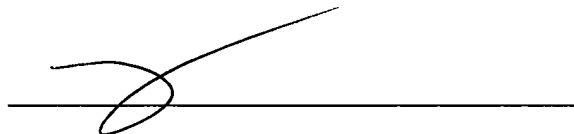
It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC

Date: 7 July 2004

A handwritten signature in dark ink, appearing to be 'Michael N. Haynes', is written over a horizontal line.

Michael N. Haynes  
Registration No. 40,014

1341 Huntersfield Close  
Keswick, VA 22947  
Telephone: 434-972-9988  
Facsimile: 815-550-8850





## CERTIFICATE OF EXPRESS MAILING

Express Mail Mailing Label Number ER 860170281 US

Date of Deposit 7 July 2004

Pursuant to 37 C.F.R. § 1.10, I certify that I am personally depositing the following paper(s) or fee(s) with the "Express Mail Post Office to Addressee" service of the United States Postal Service on the above date in a sealed envelope (a) having the above-numbered Express Mail label and sufficient postage affixed, and (b) addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450.

Stamped, self-addressed postcard for USPTO receipt stamp (1 card)

Reply Under 37 C.F.R. 1.116 to Office Action dated 8 March 2004 (30 sheets)

Declaration Under 37 C.F.R. § 1.132 of Dr. William W. Sihler (9 sheets)

PTO/SB/17 Fee Transmittal Form (1 sheet)

PTO-2038 Credit Card Payment Form (1 sheet)

Serial No. 09/650,733  
Application Filing Date: 30 August 2000  
Document Submission Date: 7 July 2004

Docket: 1011-002  
Inventor: Alejandro M. Pilato

7 July 2004  
Date

Eden Brown  
Name of Person Making Deposit

Eden Brown  
Signature of Person Making Deposit



AMENDMENT UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE

EXAMINING GROUP 3628

PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : Alejandro M. Pilato  
Serial No. : 09/650,733  
Filed : 30 August 2000  
For : METHOD AND SYSTEM FOR PROVIDING FINANCIAL  
FUNCTIONS  
Art Unit : 3628  
Examiner : Richard C. Fults

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION UNDER 37 C.F.R. § 1.132**

Sir:

I, William W. Sihler, a citizen of the United States, whose full post office address is 3215 Heathcote Lane, Keswick, VA 22947 declare as follows under penalty of perjury.

1. I hold a Doctors in Business Administration from Harvard University awarded in 1965.
2. I hold a Master of Business Administration from Harvard University awarded in 1962.
3. I hold a A.B. degree in Government from Harvard University awarded in 1959.
4. I am currently the Ronald Edward Trzcinski Professor of Business Administration at the University of Virginia.
5. Since 1965, I have worked continually in the field of Business Administration with

particular emphasis in financial management and financial services.

6. I have reviewed Application Serial No. 09/650,733.
7. I have reviewed U.S. Patents Nos. 5,644,727 (Atkins); and 6,021,397 (Jones).
8. Among the systems and methods with which I was familiar prior to 30 August 2000, the filing date of Application Serial No. 09/650,733, were systems and methods of the type recited in Atkins and Jones.
9. I have reviewed the U.S. Patent Office Action dated 8 March 2004 (“Office Action 2”) in Application Serial No. 09/650,733, which contains the following statement: “While Atkins does not explicitly teach an agent, it would have been obvious to one skilled in the art at the time of the invention that an agent is simply a representative of the principal....”
10. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733. It would not have been obvious to one skilled in the art at the time of the invention that the term “agent”, as used in Application Serial No. 09/650,733, “is simply a representative of the principal”.
11. Rather, one skilled in the art would interpret the term “agent” to mean a “financial risk manager”, as explicitly defined at line 12 on page 10 of Application Serial No. 09/650,733.
12. Moreover, one skilled in the art would instantly recognize the term “financial risk

manager”, as one at whom are directed books such as *Managing Financial Risk: A Guide to Derivative Products, Financial Engineering, and Value Maximization*, by Charles W. Smithson, Publisher: McGraw-Hill Trade; 3<sup>rd</sup> edition (June 30, 1998), ISBN: 007059354X (see back cover “for years, financial executives and risk managers have recognized Charles Smithson's *Managing Financial Risk* as the authoritative source for comprehensive coverage of risk management products.”)

13. Accordingly, one skilled in the art would not find that Atkins teaches or suggests an “agent” as that term is defined in Application Serial No. 09/650,733.
14. Moreover, one skilled in the art would find that Atkins makes no provision for an “agent” as that term is defined in Application Serial No. 09/650,733.
15. Further, one skilled in the art would not find that Jones teaches or suggests an “agent” as that term is defined in Application Serial No. 09/650,733.
16. Office Action 2 contains the following statement: “...the words ‘institutional or corporate’ are merely an intended use....”
17. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
18. Rather, one skilled in the art would interpret the words “institutional or corporate” as used in Application Serial No. 09/650,733 to be required limitations of each of claims 1-139, and to define the type of “client” cited in those claims.

19. Moreover, one skilled in the art would not find that either Atkins or Jones teaches an “institutional or corporate client”.
20. Rather, Atkins allegedly recites a “a method and apparatus for effecting an improved **personal** financial analysis, planning and management system...”. See “Summary of the Invention” at col. 7, lines 19-21.
21. One skilled in the art would not equate a “**personal** financial analysis, planning and management system” with a “financial system” used for servicing the needs of an “institutional or corporate” client.
22. Accordingly, one skilled in the art would not find that Atkins teaches an “institutional or corporate client”.
23. Further, Jones allegedly recites that “[i]n view of the foregoing, what is needed is a financial advisory system that employs advanced financial techniques to provide financial advice to **individuals** on how to reach specific financial goals.” See col. 2, lines 13-17.  
The “specific advice” provided to the user of Jones regards “steps they can take to improve their chances of meeting their financial goals while taking into consideration the user’s personal tradeoffs among risk, savings, and retirement age.” See col. 2, lines 40-45.
24. One skilled in the art would not equate “financial techniques to provide financial advice to **individuals**... while taking into consideration... personal tradeoffs among risk, savings, and retirement age” with “financial techniques” used for servicing the needs of an

“institutional or corporate” client.

25. Accordingly, one skilled in the art would not find that Jones teaches or suggests an

“institutional or corporate client”.

26. Office Action 2 contains the following statement: “Atkins explicitly discloses (see columns 1-80)... receiving financial information at the agent”. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.

27. Rather, one skilled in the art would not find that Atkins teaches or suggests “receiving financial information at the agent” or “receiving financial information at a computer of the agent”, because, at a minimum, Atkins does not teach or suggest an “agent” as defined in Application Serial No. 09/650,733.

28. Likewise, one skilled in the art would not find that Jones teaches or suggests “receiving financial information at the agent” or “receiving financial information at a computer of the agent”, because, at a minimum, Jones does not teach or suggest an “agent” as defined in Application Serial No. 09/650,733.

29. Office Action 2 contains the following statement: “Atkins explicitly discloses (see columns 1-80)... demonstrating to the client the potential transparency of activities of the agent....”

30. That statement is factually incorrect, in view of the state of the financial services art as of

30 August 2000, the filing date of Application Serial No. 09/650,733.

31. Rather, one skilled in the art would not find that Atkins teaches or suggests

“demonstrating to the client the potential transparency of activities of the agent....”

Moreover, consistent with the statement at the bottom of the first partial paragraph on page 3 of Office Action 2, one skilled in the art would not find that Atkins teaches or suggests “transparency” or “transparency of activities of the agent” as those terms are used in Application Serial No. 09/650,733.

32. Office Action 2 contains the following statement: “Jones teaches (see columns 1-24) the transparency of financial activities to the client....”

33. Although the phrase “the transparency of financial activities to the client” does not appear in any claim of the application, that statement is nonetheless factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.

34. Rather, as one skilled in the art would interpret the term “transparency” as that term is used in Application Serial No. 09/650,733, Jones makes no mention of either the term “transparency” or the concept underlying the term “transparency”.

35. Accordingly, one skilled in the art would not find that Jones teaches or suggests

“demonstrating to the client the potential transparency of activities of the agent....”,

“transparency of activities of the agent”, or “transparency” as those terms are used in

Application Serial No. 09/650,733.

36. Office Action 2 contains the following statement: “Atkins explicitly discloses (see columns 1-80)... enabling the agent to determine an action based on the analysis of risk management information created from the financial information.”
37. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
38. Rather, one skilled in the art would not find that Atkins teaches or suggests “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”, because, at a minimum, Atkins does not teach or suggest an “agent” as defined in Application Serial No. 09/650,733.
39. Similarly, one skilled in the art would not find that Jones teaches or suggests “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”, because, at a minimum, Jones does not teach or suggest an “agent” as defined in Application Serial No. 09/650,733.
40. Office Action 2 contains the following statement: “Atkins explicitly discloses (see columns 1-80)... enabling the client to monitor through a network activities of the agent....”
41. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.



42. Rather, one skilled in the art would not find that Atkins teaches or suggests “enabling the client to monitor through a network activities of the agent....”
43. Similarly, one skilled in the art would not find that Jones teaches or suggests “enabling the client to monitor through a network activities of the agent....”
44. Office Action 2 contains the following statement: “[t]here is no difference in the functions performed or how they are performed.”
45. That statement is factually incorrect, in view of the state of the financial services art as of 30 August 2000, the filing date of Application Serial No. 09/650,733.
46. Rather, due to the challenges of building the client’s trust in the agent, one skilled in the art would recognize the substantial difficulties in outsourcing financial functions and that Application Serial No. 09/650,733 teaches one or more novel and non-obvious methods, systems, and devices for overcoming those difficulties.
47. Further, one skilled in the art would not find that either Atkins or Jones teaches those substantial difficulties or any of the claimed novel and non-obvious methods, systems, or devices for overcoming them.

I further declare that all statements made herein of my own knowledge are true and that these statements were made with the knowledge that willful false statements and the like so made are

**AMENDMENT UNDER 37 C.F.R. 1.116**

**EXPEDITED PROCEDURE**

**EXAMINING GROUP 3628**

**PATENT**

**Serial No. 09/650,733**

**Attorney Docket No. 1011-002**

punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States

Code and that willful false statements may jeopardize the validity of the application or any patent

issuing thereon.

Signed this 5<sup>th</sup> day of July 2004 William W. Sihler  
Dr. William W. Sihler